

Appln. No. 09/704,134
Amdt. Dated July 14, 2005
Reply to Office Action of April 19, 2005

REMARKS

In the Office Action, claims 1-10 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Numbers 5,765,606 (Takemasa), 6,023,916 (Bouthiette) and 6,334,980 (Hayes).

In rejecting claims 1-10, the Examiner has found that Takemasa does not disclose the pharmaceutical products being dispensed into product package templates but that Bouthiette discloses a packaging kit with product package template cavities corresponding to cavities of a product package member. The Examiner then concludes that it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Takemasa by dispensing the pharmaceutical product into product package templates, as taught by Bouthiette, in order to ensure facilitated product placement into popular compartmented containers.

The Examiner next finds that neither Takemasa nor Bouthiette disclose the use of an X-Y mechanical drive to move the package templates but that it would be obvious to use the X-Y positioning table as taught by Hayes in the combination of Takemasa and Bouthiette in order to more accurately place the products.

Applicant again respectfully submits that the Hayes reference is non-analogous art. In In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) the patent involved an improvement in a metal hose clamp having a preassembly hook that was used to maintain the preassembly condition of the clamp and that was disengaged automatically when the clamp was tightened. The Examiner cited a combination of two references to support the rejection

Appln. No. 09/704,134

Amdt. Dated July 14, 2005

Reply to Office Action of April 19, 2005

of obviousness. The first reference related to a metal hose clamp without the hook, and the second described a plastic hook and eye fastener used in garments. The Federal Circuit held that the second reference was non analogous art and therefore reversed the obviousness rejection. Specifically, the court stated:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself...Oetiker's invention is simple. Simplicity is not inimical to patentability.

In the present case, Takemasa provides a method for automatically filing vials V positioned under an outlet 33B of a holder 33; Bouthiette discloses a manual pill sorting kit which uses a container defining sheet 3 having a plurality of contains 2; and Hayes discloses an apparatus for conducting biochemical reactions using a dispenser for ejecting drops of reagents 612a-612c into reaction chambers 740-742. Applicant respectfully submits that, consistent with In re Oetiker, in the present case, it can not be said that a person of ordinary skill in the art, seeking to solve the problem of packaging solid pharmaceuticals, would reasonably be expected or motivated to look to an apparatus of conducting biochemical reactions. As such, Applicant respectfully submits that Hayes is non-analogous art, and that it is improper to combine Takemasa, Bouthiette, and Hayes. Thus, Applicant respectfully

requests that the rejection be withdrawn.

Applicant further submits that even if Hayes can be said to be analogous, there is no motivation in the prior art to combine the references as asserted by the Examiner. As the Federal Circuit stated in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In the present case, the prior art did not suggest the desirability of the modification of the combination of Takemasa and Bouthiette asserted by the Examiner. Nor did the prior art suggest the desirability of the modification of the combination of Takemasa and Bouthiette with Hayes.

Furthermore, there cannot be said to be a suggestion to combine references where the only source of the suggestion comes from the present application. As stated by the Federal Circuit in ACS Hospital Sys., Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (1984):

The Court below identified no source, other than the Sonnenberg patent itself, for the suggestion to use

Appl. No. 09/704,134

Amdt. Dated July 14, 2005

Reply to Office Action of April 19, 2005

override switching means in a television rental system. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.

In the present case, the Examiner has not identified any suggestion or incentive to combine the references indicated in the Office Action, other than referring to the present invention itself. As such, Applicant respectfully submits that the combination of Takemasa, Bouthiette and Hayes asserted by the Examiner is improper, and the rejection should be withdrawn.

Additionally, In re Ratti, 270 F.2d 810, 123 USPQ 349, 123 USPQ 352 (C.C.P.A. 1959) the Federal Court stated:

We hold...that the combination of Jepson with Chinnery et al. is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in Chinnery et al. as well as a change in the basic principles under which the Chinnery et al. construction was designed to operate.

Applicant respectfully submits that to first modify the apparatus shown in Fig. 6 of Takemasa to dispense pharmaceuticals into a product package template having a plurality of cavities would amount to a substantial reconstruction or redesign. To then further modify that apparatus to include an X-Y positioning table, would amount to another substantial reconstruction or redesign.

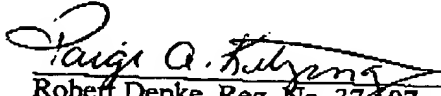
Applicant asserts that the claims of the application are allowable over the references cited by the Examiner. Should the present claims not be deemed adequate to effectively define the patentable subject matter, the Examiner is respectfully urged to call the

Appln. No. 09/704,134
Amdt. Dated July 14, 2005
Reply to Office Action of April 19, 2005

undersigned attorney of record to discuss the claims in an effort to reach an agreement toward allowance of the present application.

Respectfully submitted,

Date: 7/14/05


Robert Depke, Reg. No. 37,607
Paige A. Kitzinger, Reg. No. 45,219
Trexler, Bushnell, Giangiorgi,
Blackstone & Marr, Ltd.
105 W. Adams, 36th Floor
Chicago, Illinois 60603
Tel: (312) 704-1890
Attorneys for Applicant

832389.WPD